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ON PETITION

Hale and Dorr LLP
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Boston, MA 02109

In re Application of :
Dekker et al. :
Application No. 09/469,812 :
Filed: December 22, 1999 :
Attorney Docket No. 109846-137 :

This is a decision on the petition under 37 CFR 1.183, filed September 14, 2001, requesting waiver of 37 CFR 1.605.

The petition is **DISMISSED**.

When is waiver of a federal regulation appropriate?

In order for a petition under 37 CFR 1.183 to be granted, petitioner must demonstrate the existence of an extraordinary situation where justice requires waiver of one or more federal regulations. It is the responsibility of the Commissioner to determine the definitions of the terms "extraordinary" and "as justice requires" as the terms are used in 37 CFR 1.183.[1] The Commissioner drafted the federal regulations which may be waived including 37 CFR 1.183. The Commissioner is the party responsible for determining when a party has demonstrated that an "extraordinary" situation exists such that "justice requires" waiver of a federal regulation.

In determining when waiver is appropriate, the Office *may* consider the circumstances when courts have exercised their equitable powers to waive requirements of a statute or regulation on behalf of a party. Courts, in determining when waiver is proper, have required due diligence and have required more than a "garden variety claim of excusable neglect."[2]

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[1] See Bowles, Price Administrator v. Seminole Rock & Sand Co., 325 U.S. 410, 413-414, 89 L. Ed. 1700, 1702, 65 S. Ct. 1215, 1217 (1945) ("Since this involves the interpretation of an administrative regulation a court must necessarily look to the administrative construction of the regulation if the meaning of the words used is in doubt. . . . [T]he ultimate criterion is the administrative interpretation, which becomes of controlling weight unless it is plainly erroneous or inconsistent with the regulation.")

"In the specialized field of patent law, ... the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference." Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA)1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")).

[2] See Wiggins v. State Farm Fire and Casualty Co., 153 F. Supp. 2d 16, 21 (D. D.C. 2001) ("A court can equitably toll the statute of limitations . . . plaintiff will not be allowed extra time to file unless he has exercised due diligence, and the plaintiff's excuse must be more than a 'garden variety claim of excusable neglect.'") (citations omitted).

The applicable federal regulation (emphasis added):

37 CFR 1.605. Suggestion of claim to applicant by examiner.

(a) If no claim in an application is drawn to the same patentable invention claimed in another application or patent, the examiner may suggest that an applicant present a claim drawn to an invention claimed in another application or patent for the purpose of an interference with another application or a patent. The applicant to whom the claim is suggested **shall amend the application by presenting the suggested claim** within a time specified by the examiner, not less than one month. Failure or refusal of an applicant to timely present the suggested claim shall be taken without further action as a disclaimer by the applicant of the invention defined by the suggested claim. At the time the suggested claim is presented, the applicant may also call the examiner 's attention to other claims already in the application or presented with the suggested claim and explain why the other claims would be more appropriate to be designated to correspond to a count in any interference which may be declared.

MPEP 2305 (emphasis added):

2305 Examiner Suggests Claim to Applicant

Also under 37 CFR 1.605(a), when an examiner suggests a claim, the applicant will be **required to copy verbatim the suggested claim**. At the time the suggested claim is copied, however, the applicant may also (A) call the examiner's attention to other claims already in the application or which are presented with the copied claim and (B) explain why the other claims would be more appropriate to be designated to correspond to a count in any interference which may be declared. **A reply to the examiner's suggestion of a claim is not complete unless it includes an amendment adding the exact claim suggested to the application**. Even though the applicant may consider the suggested claim unpatentable, too narrow, or otherwise unsuitable, it must be presented; otherwise, the invention defined by the suggested claim is considered to be disclaimed. The applicant must make known any such objections to the examiner, and may at the same time present other claims, or call the examiner's attention to other claims already in the application, and explain why those claims would be more appropriately designated to correspond to a count in the interference. The examiner may then determine whether the applicant's alternatively proposed claims are more appropriate than the claim suggested.

Facts:

On March 28, 2001, a non-final Office action was mailed to petitioner. The cover page stated, "A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION." The cover page stated that extensions of time were available.

The first page of the Office action suggested a claim for interference and stated, "Applicant should make the suggested claim within ONE MONTH or THIRTY DAYS from the mailing date of this letter, whichever is longer." The second page of the Office action stated that extensions of time were not available to make the suggested claim.

Therefore, the Office action set two separate time periods. One for responding to the suggested claim for interference, and a separate time period for responding to the rest of the Office action.

Petitioner argues that the notice for the one month time period was placed in the body of the Office action and that "the time restraints for response to an Office Action are normally ascertained by identifying the mailing date of the document and examining requirements detailed on the [cover sheet]."

On August 28, 2001, petitioner submitted an amendment and the instant petition, and a request for an extension of time.

Application of the law to the facts:

37 CFR 1.605 states that petitioner must submit the suggested claim within the time period set by the examiner. The issue presented by petitioner appears to be, should the alleged ambiguity regarding the time period to reply to the Office action result in a decision to grant petitioner the longer time period?

It is unnecessary to address the above issue in so far as the suggested claim was not submitted by petitioner within either the one month period or the three month extendable time period. As of February 25, 2002, the suggested claim has not been submitted by applicant.

37 CFR 1.605(a) states in part (emphasis added),

> The applicant . . . **shall amend** the application by **presenting the suggested claim** within a time specified by the examiner. . . . Failure or refusal of an applicant to timely present **the suggested claim** shall be taken without further action as a disclaimer by the applicant of the invention defined by the suggested claim.

Petitioner has not submitted the suggested claim.

As stated in MPEP 2305, petitioner was "required to copy verbatim the suggested claim. . . . A reply to the examiner's suggestion of a claim is not complete unless it includes an amendment adding the exact claim suggested to the application."

The Office action clearly states, "The suggested claim must be copied exactly, although other claims may be proposed under 37 CFR § 1.605(a)."

Petitioner's failure to file the suggested claim is not an extraordinary situation where justice requires waiver of the rule.

The Federal Circuit has stated, "Equitable powers . . . should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable due care and diligence."[3] An attorney's, or agent's, lack of knowledge, misinterpretation of a law, miscalculation of a time period, or failure to exercise due care and diligence will not justify waiver.[4]

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[3] U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983) (citations omitted) ("Lockheed had several means at its disposal which it could have employed to guarantee compliance with the regulation, yet it neglected to use any of them. Equitable powers . . . should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable due care and diligence."); See also Grymes v. Sanders et al., 93 U.S. 55, 61; 23 L. Ed. 798, 801 (1876) ("Mistake, to be available in equity, must not have arisen from negligence. . . . The party complaining must have exercised at least the degree of diligence 'which may be fairly expected from a reasonable person.') (citing Kerr on Fraud and Mistake, 407); Garcia v. Office of Personnel Management, 2001 U.S. App. LEXIS 21616, 6 (Fed. Cir. 2001) ("Equity will not intervene, however, to protect a claimant from his or her own failure to exercise due diligence in preserving their legal rights.") (citing Irwin v. Department of Veterans Affairs, 498 U.S. 89, 95 (1990)); Goetz & Goetz v. Secretary of Health and Human Services, 2001 U.S. App. LEXIS 943, 5 (Fed. Cir. 2001) ("the special master's finding of a lack of due diligence was not arbitrary, capricious, or an abuse of discretion, and precludes the application of equitable tolling.") (citing Baldwin County Welcome Ctr. V. Brown, 466 U.S. 147, 151, 80 L. Ed. 2d 196, 104 S. Ct. 1723 (1984) which states, "One who fails to act diligently cannot invoke equitable principles to excuse their lack of diligence.")

[4] See Felder v. Johnson, 204 F.3d 168 171-172 (5th Cir. 2000) (Pro se status is not "rare and exceptional" circumstance, but is typical of those bringing a 28 U.S.C. § 2254 claim. "Mere ignorance of the law or lack of knowledge of filing deadlines does not justify equitable tolling or other exceptions to a law's requirements.") (citing United States v. Flores, 981 F.2d 231, 236 (5th Cir. 1993) as "holding pro se status, illiteracy, deafness, and lack of legal training are not external factors excusing abuse of the writ."); citing Barrow v. New Orleans S.S. Ass'n, 932 F.2d 473, 478 (5th Cir. 1991) as "holding equitable tolling . . . within the Age Discrimination in Employment Act not warranted by plaintiff's unfamiliarity with legal process, his lack of representation, or his ignorance of his legal rights.": other citations omitted). See also Harris v. Hutchinson, 209 F.3d

Petitioner failed to comply with the language in the Office action. Petitioner failed to comply with the language in the MPEP. Petitioner failed to comply with 37 CFR 1.605(a). Petitioner failed to act with reasonableness, due care, and diligence when the choice was made to ignore the language of the Office action, MPEP, and federal regulation.

Petitioner argues that a substantially similar claim exists in the application when one reads claim 8 and claim 2 together. However, the existence of the alleged substantially similar claim did not prevent petitioner from filing the suggested claim with the instant petition. Perhaps petitioner feels that the substantially similar claim is more appropriate for the interference, but even if such an assertion is correct, the presence of the claim does not justify petitioner's failure to file the suggested claim. 37 CFR 1.605 states,

> Even though the applicant may consider the suggested claim unpatentable, too narrow, or otherwise unsuitable, it must be presented . . . applicant must make known any such objections to the examiner, and may at the same time present other claims, or call the examiner's attention to other claims already in the application, and explain why those claims would be more appropriately designated to correspond to a count in the interference. The examiner may then determine whether the applicant's alternatively proposed claims are more appropriate than the claim suggested.

Petitioner had the capability to file the suggested claim, but chose not to file the claim. Petitioner's conduct does not justify waiver of 37 CFR 1.183.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.

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Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

325, 330-331 (4th Cir. 2000) (Plaintiff argues that he relied on "negligent and erroneous advice" of his attorney. Attorney agrees his advice was erroneous. The court holds, "[A] mistake by a party's counsel in interpreting a statute of limitations does not present the extraordinary circumstance beyond the party's control where equity should step in to give the party the benefit of his erroneous understanding.") (citing Taliani v. Chrans, 189 F.3d 597, 598 (7th Cir. 1999) as "holding that a lawyer's miscalculation of a limitations period is not a valid basis for equitable tolling."; citing Sandvik v. United States, 177 F.3d 1269, 1272 (11th Cir. 1999) (per curiam) as "refusing to toll the limitations period where the prisoner's delay was assertedly the result of a lawyer's decision to mail the petition by ordinary mail rather than to use some form of expedited delivery."; citing Gilbert v. Secretary of Health and Human Services, 51 F.3d 254, 257 (Fed. Cir. 1995) as "holding that a lawyer's mistake is not a valid basis for equitable tolling."; other citations omitted.)